

PATENT**C. REMARKS****1. Examiner Interview**

Applicants note with appreciation the telephonic interview conducted between Applicants' attorney and the Examiner on October 22, 2003. During the telephonic interview, Applicants' attorney and the Examiner discussed the three references cited in the Office Action. Applicants' attorney and the Examiner discussed possible amendments to the claims and the Examiner requested that Applicants cite support in the specification for any new claim limitations added by amendment. No agreement regarding the claims was reached between Applicants' attorney and the Examiner.

2. Summary

Claims 1-24 stand rejected are currently pending in the application. Claims 6, 11, 18, and 38 are independent claims. Claims 1-5, 10, 14-17, and 21-24 have been canceled. Claims 6-9, 11-13, and 18-20 have been amended. Claims 25-38 have been added. No new matter has been added in light of these amendments.

Support in the specification for Applicants' amendments can be found throughout the specification, including the summary, abstract, Figure 11, and pages 35-38 of the detailed description.

3. Drawings

No indication was made in the Office Action as to whether the formal drawings filed with the Application are accepted by the Examiner. Applicants respectfully request that the Examiner indicate whether the drawings are acceptable in the next communication.

4. Claim Rejections – 35 U.S.C. § 112

Claim 5 was rejected under 35 U.S.C. § 112. This rejection no longer applies because both claim 5 and claim 2 have been cancelled.

5. Claim Rejections – 35 U.S.C. § 102(e)

Claims 1, 11, and 18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,496,568 to Nelson (hereinafter "Nelson"). Claim 1 has been cancelled. Claims 11

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and 18 have been amended in such a way to be an information handling claim and a computer program product claim with the same limitations as independent method claim 6. Claim 6 currently stands rejected under 35 U.S.C. § 103 as being obvious in light of Nelson in light of U.S. Patent No. 6,327,574 to Kramer et al. (hereinafter "Kramer") in view of U.S. Patent No. 6,453,687 to Sharood et al. (hereinafter "Sharood"). In light of Applicants' amendments to the claims, the 102(e) rejection does not apply as Applicants have included the limitations of amended claim 6. Therefore, the rejections of claims 11 and 18 are discussed along with Applicants' remarks concerning Claim 6 in the following section.

6. Claim Rejections – 35 U.S.C. § 103

Independent Claim 6 stands rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 6,496,568 to Nelson (hereinafter "Nelson") in light of U.S. Patent No. 6,327,574 to Kramer et al. (hereinafter "Kramer") in view of U.S. Patent No. 6,453,687 to Sharood et al. (hereinafter "Sharood"). As pointed out in the preceding section, independent claims 11 and 18 now include the limitations of claim 6 and are, respectively, directed towards an information handling claim and a computer program product claim. Except for new independent method claim 38, each of the remaining dependent claims depends upon either claim 6, 11, or 18. Therefore, the allowability of each of the remaining claims is discussed in light of the claims' non-obviousness over Nelson in light of Kramer in view of Sharood. Applicants respectfully traverse the rejections of the remaining claims.

Applicants assert that the Office Action fails to establish a prima facie case of obviousness under § 103 as set forth in § 103 and the MPEP. MPEP 2142 states that:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

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Applicants assert that the Office Action fails to show that the prior art references teach or suggest all of Applicants' claim limitations. In particular, Applicants assert that the Office Action fails to view Applicants' invention as a "whole." MPEP 2141 states that "*When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole...*" Applicants' original claim 7 claimed "registering" the home automation system to the email system. However, the Office Action does not even address this limitation, as it is completely lacking in any of the references. In particular, Sharood does not teach or suggest registering the automation system with an email system. The limitations of claims 8 and 9 were also not considered in the Office Action. In claim 8, Applicants claim the limitation of setting a "travel" home automation setting. Sharood does not teach or suggest a special "travel" setting, nor does the Office Action cite any portion of Sharood as teaching this limitation. Finally, claim 9 claims using a secure protocol to transfer messages from the email system to the home automation system. Once again, the Office Action does not cite any portion of any reference in its rejection of this claim.

None of the references cited teach "registering" a home automation system with an email system, as taught and claimed by Applicants (see original claim 7, Figure 11, specification p. 35-38). Applicants' registration step links the home automation system to an email system and provides the email system with a network address that corresponds to the home automation system. When the email system receives a travel message, it responds by automatically notifying the home automation system. The only prior art reference that deals with automation systems is the Sharood reference. However, Sharood is primarily focused on monitoring and control of a building control (BC) system, and does not teach or suggest interfacing a home automation system with an email computer system. Sharood states that devices that supervise the BC system include "local user interfaces or Internet-based remote interfaces." (col. 4, lines 46-47). Furthermore, Sharood shows various ways of connecting to the BC system in Figure 8, however nowhere in Figure 8 does Sharood teach or suggest "registering" the BC system with an email system, nor does Sharood teach or suggest receiving messages from the email system to control operation of the automation system. Instead, in Figures 13-17, Sharood shows that one way of controlling the BC system is by using a Web-based system that displays Web pages that allow the user to access the automation system through the Internet.

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Conversely, in Applicants' claimed invention, the home automation system receives instructions forwarded to it from the email system. The home automation system registers with the email system so that the email system knows the network address belonging to the home automation system so that the email system can automatically send notifications to the home automation system. A travel agent computer system is used to receive travel plans from the user. The user can interface with the travel agent computer system in a variety of ways, such as using email, or telephone instructions. When the travel agent computer system receives a travel request from a user, it sends the travel plans to the email system. The email system, upon receiving the travel plan message, retrieves the home automation system's network address that was stored by the email system during the registration process. The email system then sends a notification to the home automation system, the notification including a command based upon the user's travel plans. The home automation system receives the message and responds accordingly (i.e., activates or deactivates the system). These limitations simply are not taught or suggested by Sharood. In particular, neither Sharood, nor Nelson or Kramer teach or suggest using the three systems taught and claimed by Applicants, namely the travel agent system, the email system, and the home automation system. In Applicants' claimed invention, these systems *interoperate* to provide a user with one way of controlling a home automation system. Since the prior art references do not teach the use of the systems, it therefore follows that the prior art references do not teach or suggest the *interoperation* of these systems with one another.

Applicants assert that the rejection uses impermissible hindsight in concluding that Applicants' claims are obvious. As stated in MPEP § 2145:

"Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, '[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.' In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)."

Applicants assert that the rejection relies on knowledge gleaned only from Applicants' disclosure in contravention of MPEP § 2145. The Office Action combines the notification system of Nelson, that does not teach or suggest notifying a home automation system, with the

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refrigeration monitoring system of Sharood, which does not teach or suggest incorporating the system with a notification system, with the consumer attributes for targeting online content system of Kramer, that also does not teach or suggest either use of a home automation system nor does it teach or suggest use of a notification system.

It appears that the Office Action impermissibly searched for individual limitations claimed by Applicants with no regard whatsoever as to whether there actual exists a motivation to combine the references. The Office Action states that combining the references would be obvious "because it would allow to provide [sic] the consumer with additional services relating to his home automation system, thereby making the system more attractive to consumers." This reasoning is plainly far-reaching and impermissible under current patent laws and rules, in particular MPEP § 2145. The only "obvious" aspect of Applicants' invention is that the Office Action impermissibly reconstructed Applicants' invention with knowledge gleaned only from Applicants' disclosure. Furthermore, Applicants assert that using the reasoning set forth in the Office Action would render most every invention on the planet as "obvious" as the Examiner would only have to find a reference that taught or suggested individual elements without regard as to whether a motivation to combine the references actually exists.

Claim 7 claims sending an electronic message from the email system to the home automation system. The Office Action fails to show any reference that teaches or suggests sending a message from an email system to a home automation system. Sharood merely teaches using a Web-based interface over the Internet to display and set controls in an automation system. Sharood never teaches or suggests sending a message from an email system to a home automation system. Therefore, neither Nelson, Kramer, nor Sharood, alone or in combination with one another, teach or suggest sending a message from an email system to a home automation system.

Claim 8 claims setting a "travel" home automation setting in the home automation system. The Office Action fails to show any reference that teaches or suggests a special "travel" automation setting. Sharood never teaches or suggests such a setting. Therefore, neither Nelson, Kramer, nor Sharood, alone or in combination with one another, teach or suggest a "travel" automating setting.

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Claim 9 claims using a secure transmission protocol to send the message from the email system to the home automation system. As discussed above, Sharood only teaches using a Web-based interface to access and control the automation system through the Internet. Neither Sharood, Nelson, nor Kramer, alone or in combination with one another, teach or suggest sending a message from an email system to a home automation system using a secure protocol.

Claims 7-9 and new claims 25-29 each depend on claim 6 and, therefore, are allowable for at least the reasons that claim 6 is allowable. Claim 11 is an information handling claim that includes the same limitations as claim 6. Therefore, claim 11 is allowable for at least the reasons that claim 6 is allowable. Claims 12-13 and new claims 30-33 each depend on claim 11 and, therefore, are allowable for at least the reasons that claim 11 is allowable. Claim 18 is a program product claim that includes the same limitations as claim 6. Therefore, claim 18 is also allowable for at least the reasons that claim 6 is allowable. Claims 19, 20 and new claims 34-37 each depend on claim 18 and, therefore, are allowable for at least the reasons that claim 18 is allowable. New independent claim 38 includes the limitations of claim 6 as well as further limitations not found in the prior art. Therefore, claim 38 is allowable for at least the same reasons that claim 6 is allowable.

Applicants have successfully traversed the rejections of the remaining claims. Furthermore, Applicants have shown that the Office Action used impermissible hindsight in rejecting Applicants' claims as obvious. Applicants have also shown that the Office Action failed to provide a motivation to combine the references as no motivation appears in the references themselves and the only motivation stated in the Office Action are that Applicants' invention would "benefit" consumers which, using circular reasoning, would motivate one of skill in the art to combine the references.

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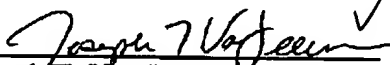
Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

By



Joseph T. Van Leeuwen

Attorney for Applicant

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Interview Summary	Applicati n No. 09/704,573	Applicant(s) RODRIGUEZ ET AL.	
	Examin r Igor Borissov	Art Unit 3629	

All participants (applicant, applicant's representative, PTO personnel):

- (1) Igor Borissov. (3)____.
- (2) Joseph T. Van Leeuwen. (4)____.

Date of Interview: 22 October 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.
If Yes, brief description: _____.

Claim(s) discussed: 2-10.

Identification of prior art discussed: Kramer et al. (U S6,327,574) and Sharood et al. (US 6,453,687).

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The applicability of the prior art (see above) was discussed.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

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EXAMINER INTERVIEW - PROPOSED AGENDA

DATE: 10/21/2003
 TO: EXAMINER IGOR BORISSOV
 FAX/PH: 703-746-8493 (FAX) 703-305-4649 (PHONE)
 FROM: JOSEPH T. VAN LEEUWEN
 FAX/PH: 512-301-6742 (FAX) 512-301-6738 (PHONE)
 RE: 09/704,573

Examiner Borrissov:

During of our telephone interview scheduled for tomorrow at 3:00PM EDT (Wednesday Afternoon October 22, 2003), I would like to discuss the following:

- Discuss the inapplicability of U.S. Pat. No. 6,327,574 to Kramer et al. ("Kramer") cited in the § 103 rejection. Kramer is focused on providing content, such as advertisements, to consumers in a manner preserving the consumers' privacy (i.e., those consumers that receive the information). In contrast, Applicant claims a system for a user to send his or her travel plans to various contacts (e.g., spouses, colleagues, etc.). Therefore, in Applicants' invention it is the sender's data / identity that is sensitive, the privacy of which is maintained by the system.
- In claim 3, Applicants claim a method of contacting contacts using a variety of methods (email, pager, telephone, etc.). Kramer only teaches contacting users through an Internet web page (see Figs. 17 & 18 of Kramer). Kramer does not teach or suggest contacting users by telephone or pager. "at least one. Also, C.Z. 56-57" *delivered electronically*
- Kramer teaches a consumer's profile that is used to determine content that is sent to the consumer (col. 2, lines 56-67). In stark contrast, the profile claimed in Applicants' claim 4 is used to determine the content regarding the user that is sent to others (the user's contacts such as spouse, colleagues, etc.).
- Basically, the above 3 items show that Kramer teaches managing transmission of data to consumers based on the consumers' interests while Applicants claim a method of allowing a user to control what content about the applicant is sent to the user's contacts. Therefore, Kramer does not teach or suggest applicants' invention as claimed in claims 2-4, 15-17, and 22-24. *} same*
- Discuss the inapplicability of U.S. Patent 6,453,687 to Sharood et al. ("Sharood"). Sharood teaches a refrigeration monitor unit that is attached to a refrigerator to warn a user if a condition exists in the appliance where food may spoil. While the system taught by *home automation syst*

10/03/2003

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- Sharood can be controlled remotely, nowhere does Sharood teach or suggest that such automation is achieved by the system receiving the user's travel plans, as claimed by Applicants in claims 6-10.
- There does not appear to be any motivation to combine the references of Sharood with the other references (Kramer & Nelson) cited in the Office Action. I would like to discuss where such motivation is shown, in the references themselves, to combine the refrigeration monitor unit of Sharood with the models of consumer attributes taught by Kramer and the automatic notification taught by Nelson.

I will call you at 3:00PM EDT tomorrow Wednesday to discuss this application and office action.

Thank you for your time and consideration.

Joe Van Leeuwen